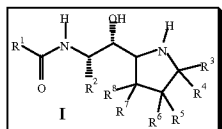


Status of the Claims / Priority


Claims 2, 8, 11 and 13 are pending in the current application. This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/US2005/12191, filed April 8, 2005, which claims priority under 35 U.S.C. § 119(e) to US Provisional Application No. 60/564,538, filed April 22, 2004.

Status of Restrictions / Election of Species

Applicant's affirmation of the following election, with traverse, in the reply filed on



November 20, 2008, is acknowledged: a) Group I, claims 2, 8 and 13, where

 **I** $R^1 = (C_3-C_7\text{cycloalkyl})_{0-1}(C_1-C_6\text{alkyl}); R^2 = \text{-benzyl}; R^3 \text{ and } R^4, \text{ taken together with the carbon to which they are attached, cannot form a } C_3-C_6 \text{ cycloalkyl ring}; R^5 \text{ and } R^6, \text{ taken together, cannot form } =\text{CHC(O)}(C_1-C_4\text{alkoxy}); \text{ and } R^7 \text{ and } R^8, \text{ taken together, cannot form a bond; and b) substituted pyrrolidine of formula I(a) - p. 160, example 33.}$

The requirement was made FINAL in the *Non-Final Rejection*, mailed on January 29, 2009.

This application contains claim 11, drawn to a nonelected invention, without traverse, in the reply filed on April 29, 2009. A complete reply to the non-final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

The sections of U.S.C. Title 35 that formed the basis of prior rejections formulated, as well as any references supporting said rejections, that are not included with this Office action,

Art Unit: 1624

may be found in either the *Non-Final Rejection*, mailed on August 20, 2008, or the *Non-Final Rejection*, mailed on January 29, 2009. Furthermore, any rejections or objections of record not explicitly addressed herein below, are hereby withdrawn, in light of applicant's arguments, filed April 29, 2009.

Thus, a third Office action and prosecution on the merits of claims 2, 8 and 13 is contained within.

Status of Claim Rejections - Obviousness-type Double Patenting

Applicant's arguments, on page 4 of the *Remarks*, filed April 29, 2009, with respect to claims 2, 8 and 13, have been fully considered, but are not persuasive. Consequently, the rejection of claims 2, 8 and 13, made in the *Non-Final Rejection*, mailed on January 29, 2009, is hereby maintained for the reasons of record.

Applicant primarily argues that the double patenting rejection is premature, since no claims have yet been allowed in either of the copending applications. Applicant further argues that according to MPEP § 804, since the provisional double patenting rejection is the only rejection remaining in the present application, the rejection should be withdrawn and the claims allowed.

In response to applicant's arguments that according to MPEP § 804, since the provisional double patenting rejection is the only rejection remaining in the present application, the rejection should be withdrawn and the claims allowed, the examiner respectfully disagrees. MPEP § 804 fully states that "if *provisional* ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the *earlier filed* application, thereby permitting that application to issue without need of a terminal

Art Unit: 1624

disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. *If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations).* The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.” In the instant case, the rejection of record has been maintained for the following reasons: 1) the instant application and copending application are filed on the same day; and 2) the relationship between the instant application and copending application does not permit the examiner to *reasonably* determine either as the *base invention* or the *improvement*.

In a subsequent telephone interview on May 14, 2009 with Mr. Robert D. Titus on behalf of Ms. Elizabeth A. Dingess-Hammond, attorney for applicant, the examiner agreed to withdraw the provisional obviousness-type double patenting rejection and pass this case to issue, since applicant agreed to either cancel the conflicting subject matter in copending application 10/599,125 or file a *Terminal Disclaimer* over the patent issued from instant application 10/599,129. An *Examiner's Initiated Interview Summary* is included with this Office action.

Reasons for Allowance

Claims 2, 8 and 13 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art is silent with regard to pyrrolidines substituted with R^I , as recited in claim 2.

Consequently, the limitation on the core of the substituted pyrrolidines of the formula I(a) that is not taught or fairly suggested in the prior art is R^I on the periphery of the pyrrolidine core.

Art Unit: 1624

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled *Comments on Statement of Reasons for Allowance*.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The following is a statement of examiner's amendment to the record: claim 11 is hereby cancelled.

Claim 11 has been cancelled.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Robert D. Titus (Reg. No. 40,206) on behalf of Ms. Elizabeth A. Dingess-Hammond (Reg. No. 63,996) on May 14, 2009.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS M. WILLIS, whose telephone number is 571-270-5757. The examiner can normally be reached on Monday thru Thursday from 8:00-6:00 EST. The examiner can also be reached on alternate Fridays.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOUGLAS M WILLIS/
Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, AU 1624**